

Application No.: 10/615663

Case No.: 58635US002

REMARKS

The Office Action dated June 10, 2004 has been received and reviewed. New claims 26-34 have been added. Claims 1-17 have been cancelled. Applicant reserves the right to pursue the subject matter of cancelled claims 1-17 in subsequently-filed divisional and continuation applications. Claims 18-34 are pending with claims 22-25 having been withdrawn from consideration.

Restriction Requirement

Claims 1-24 were restricted under 35 U.S.C. § 121 as follows:

I. Claims 1-10 are said to be drawn to a lens having a centration mark, classified in Class 351, subclass 159;

II. Claims 11-17 are said to be drawn to a method of making a lens centration mark, classified in Class 351, subclass 177; and

III. Claims 18-25 are said to be drawn to a method of measuring centration of a lens, classified in Class 351, subclass 178.

Further, Group III was restricted as having the following patentably distinct species: Group IIIa, claims 18-21, which disclosed a method of analyzing the centration of a lens, specifically by leveling the lens relative to a plane of rotation orthogonal to the rotation axis of a platen and rotating the lens about the rotation axis; and Group IIIb, claims 22-25, which discloses a method of analyzing the centration of a lens, specifically by positioning the lens in a first position and a second position and comparing the centration marks at the first and second locations. None of the claims of Group III were found to be generic.

During a telephone conversation with the Examiner on June 1, 2004, Applicant's Representative Jay Pralle provisionally elected Group IIIa, claims 18-21 with traverse. Applicant hereby affirms the election of Group IIIa, claims 18-21 without traverse.

The 35 U.S.C. § 103(a) Rejection

Claims 18-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hollmann et al. (U.S. Patent No. 5,835,208) in view of Abrams (U.S. Patent No. 5,503,694).

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Applicant traverses this rejection and submits that claims 18-21 are not *prima facie* obvious in view of the combination of Hollmann et al. and Abrams because such combination does not teach all of the elements of claims 18-21.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143.

Claim 18 of the present application recites a method of measuring centration of a lens. As is clearly defined in the Specification, the term "decentration" or lack of centration, refers to any lack of coincidence between the optical and mechanical axes of a lens. *See* Specification, page 7, lines 5-6. For a perfectly centered lens surface, the mechanical axis of the lens is coincident with the optical axis. *Id.* at page 7, lines 6-7. For surfaces having a lens centration mark, decentration of the surface would be indicated if the lens centration mark is not aligned with the mechanical axis of the lens. *Id.* at page 7, lines 7-9. The method as recited by claim 18 includes observing the lens during or after rotation to assess centration of the first major surface of the lens.

In contrast to claim 18, Hollmann et al. describes a measuring apparatus 10 for centering and determining wedge error of an optical element 12 under test. *See* Hollmann et al. Abstract. The Office Action alleges that Hollmann et al. discloses a method of measuring centration of a lens, citing the Abstract, Column 5, lines 44-56, and column 6, lines 15-23 of Hollmann et al. for support of this allegation.

Applicant traverses this allegation. The passages of Hollmann et al. cited by the Office Action do not disclose a method of measuring centration. Instead, such passages describe a method of mechanically centering a lens 12 on a lens holder 16. Hollmann et al. teaches a V-shaped guide 100 provided in the lens holder 16 that helps "facilitate centering of the optical element 12 on the lens holder 16...." *Id.* at column 5, lines 15-17. Further, Hollmann et al. teaches a method of determining whether the lens is round, not whether a surface of the lens

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exhibits decentration. *See id.* at column 6, lines 15-24. In other words, the passages of Hollmann et al. relied upon by the Office Action do not teach a method of measuring any lack of coincidence between the optical and mechanical axes of a lens, i.e., decentration.

Further, claim 18 recites placing the lens on a platen, where the lens includes a first major surface and a second major surface. The first major surface of the lens is rotationally symmetrical about a first axis, where the first major surface includes a first lens centration mark located at the intersection of the first major surface and the first axis. Claim 18 further recites that placing the lens on the platen includes placing the lens on the platen such that the first lens centration mark is aligned with a rotation axis of the platen.

The Office Action alleges that FIGS. 1-4 of Hollmann et al. teach a lens that is rotationally symmetric about the central axis through the center of the lens. Applicant traverses this allegation. Hollmann et al. is silent regarding whether lens 12 is rotationally symmetrical about a first axis as is recited in claim 18 of the present application. None of the figures referred to by the Office Action indicate or call out an axis of revolution for either surface of lens 12.

Further, the Office Action admits that Hollmann et al. does not teach a lens that includes a first lens centration mark as is recited in claim 18.

Finally, claim 18 also recites leveling the lens relative to a plane of rotation that is orthogonal to the rotation axis of the platen. In contrast to claim 18, Hollmann et al. does not teach or suggest a leveling step as is alleged by the Office Action. Further, FIGS. 1-4, which were cited by the Office Action as teaching a leveling step, do not indicate that lens 12 is leveled.

The addition of Abrams does nothing to cure the above-mentioned deficiencies present in Hollmann et al. For example, Abrams teaches a composite lens laminating system for laminating or bonding together front and rear lenses to form a composite eyeglass lens. *See Abrams, Abstract.* Abrams, however, does not teach or suggest a method for measuring centration of a lens. The alleged first centration mark of Abrams (i.e., the center ink mark located at the optical center of rear lens 15) is placed on laminating axis 35 such that the optical center of the composite lens is properly positioned in front of the pupil of the user's eye. *See Abrams, column 3, lines 34-59.* However, the center ink mark is not used to measure centration of the rear lens 15. Therefore, Abrams does not teach or suggest measuring centration of either the rear lens 15, the front lens 10, or the composite lens formed from the two lenses.

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Therefore, neither Hollmann et al. nor Abrams, either alone or in combination, teach or suggest all of the elements of claim 18.

Claims 19-21, which depend from independent claim 18, are not *prima facie* obvious for the same reasons as presented above for claim 18. In addition, claims 19-21 each recite additional elements that further support patentability when combined with claim 18.

For at least the above reasons, Applicant submits that claims 18-21 are patentable over the combination of Hollmann et al. and Abrams. Reconsideration and withdrawal of the rejection are, therefore, respectfully requested.

SUMMARY

It is respectfully submitted that the pending claims are in condition for allowance. Reconsideration and withdrawal of all rejections are respectfully requested. The Examiner is invited to contact Applicant's Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,

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Date

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